

REMARKS

By this Amendment, Applicants amend claims 1, 10, and 55 and cancel claim 2. Accordingly, claims 1 and 3-55 are pending in this application. Applicants respectfully request reconsideration of the pending claims at least in light of the following remarks.

The Office Action provisionally rejects claims 1-55 for obviousness-type double patenting over claims 1-21 of co-pending Application No. 11/032,141. Applicants recognize the rejection. As the rejection is provisional, Applicants will determine how to respond upon the earlier of the issuance of co-pending Application No. 11/032,141 as a patent or the allowance of the pending claims.

The Office Action objects to claim 10 for an informality. By this Amendment, Applicants amend claim 10 to obviate the objection. Accordingly, Applicants respectfully request withdrawal of the objection.

The Office Action rejects to claim 55 under 35 U.S.C. §112, second paragraph, as indefinite. By this Amendment, Applicants amend claim 55 to obviate the rejection. Accordingly, Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 1-2, 16-18, 26, and 29-31 under 35 U.S.C. §103(a) over U.S. Patent No. 4,590,934 to Malis et al. (hereinafter "Malis I") in view of U.S. Patent No. 6,093,186 to Goble et al. (hereinafter "Goble"). Applicants respectfully traverse the rejection.

In order to establish a prima facie case of obviousness, three criteria must be met (MPEP §§ 2142, 2143). 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings. 2) There must be a reasonable expectation of success. 3) The prior art reference (or references when combined) must teach or suggest all

of the claim limitations. The first two criteria must both be found in the prior art, and not based on Applicant's disclosure.

Applicants respectfully submit that the Office Action fails to satisfy at least the first criteria. Specifically, the Office Action has failed to identify a suggestion or motivation to combine the alleged teachings of Malis I and Goble since there can be no suggestion or motivation when the alleged combination would change the principle of operation of the primary reference or render the reference inoperable for its intended purpose (MPEP §2143.01).

Malis I discloses a generator in which the output stage effectively has a variable output impedance. The two transistors Q1 and Q2 in Fig 3 act in a variable (linear) arrangement, such that the output impedance is low when the device is supplying power into a high impedance load, but much higher when the device is supplying power into a low impedance load. This is necessary because of the fixed line voltage supply. The resonant tank circuit, which is in parallel with the output devices, initially offers a low impedance, building to a high impedance as the circuit becomes excited.

Goble discloses a reactive output impedance that is created by deliberately running the series resonant output of a series resonant circuit “off-tune.” The series resonant circuit of Goble will initially provide a high impedance, which then falls to a low impedance as the resonant circuit becomes excited. Thus, the series resonant circuit of Goble acts in a completely different way to that of the circuit of Malis I. It is therefore not technically feasible to combine the teachings of Malis I and Goble to try and add a series resonant output circuit, which provides high impedance when excited, to the device of Malis I, which expects low impedance when excited.

Thus, attempting to combine the series resonant circuit of Goble, which acts in a completely different way to that of the circuit of Malis I, would render the device of Malis I)

unsuitable for its intended purpose, since the expected and workable impedance level at excitement would be the opposite of that necessary for operation, and 2) inoperable, since the opposite impedance would prevent the desired results in Malis I. Thus, according to MPEP§ 2143.01, the Office Action has failed to provide some suggestion or motivation to modify the reference or combine reference teachings, as required to establish a prima facie case of obviousness under 35 U.S.C. §103(a). Therefore, the rejection is improper. Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 3-7, 11-15, 19-21, 24, 25, 27, 28, 32-38, 41-46, and 51-54 under 35 U.S.C. §103(a) over the combination of Malis I and Goble, and further in view of U.S. Patent No. 5,318,563 to Malis et al. (hereinafter "Malis II"). The Office Action rejects claims 8-10 over the combination of Malis I, Goble, and Malis II, and further in view of U.S. Patent Application Publication No. 2002/0165530 to Harano et al. The Office Action rejects claims 39 and 47-50 over the combination of Malis I, Goble, and Malis II, and further in view of U.S. Patent No. 6,228,081 to Goble. The Office Action rejects claim 40 over the combination of Malis I, Goble, and Malis II, and further in view of U.S. Patent No. 5,693,084 to Eggers. Applicants respectfully traverse the rejections.

Each of these rejections is premised upon the presumption that the Office Action has provided motivation to combine Malis I and Goble. Because, as discussed above, the Office Action has failed to provide such motivation, the rejections are improper. Applicants respectfully request withdrawal of the rejections.

The Office Action rejects claims 1, 22, and 23 under 35 U.S.C. §103(a) over Malis I in view of U.S. Patent No. 5,067,953 to Feucht et al. (hereinafter "Feucht") Applicants respectfully traverse the rejection.

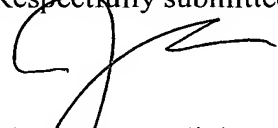
By this Amendment, Applicants amend claim 1 to include the features of canceled claim 2. Neither Malis I nor Feucht disclose the features of canceled claim 2, as evidenced by

the Office Action's failure to include claim 2 in the present rejection. Accordingly, amended claim 1 is patentable over the combination of Malis I and Feucht. Further, claims 22 and 23 are patentable for at least the reasons that claim 1 is patentable, as well as for the additional features they recite. Applicants respectfully request withdrawal of the rejection.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1 and 3-55.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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